



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,247	12/19/2001	Robert D. Covington	635482.625.036	8138

7590 08/31/2005

Ronald A. Sandler
Jones, Day, Reavis & Pogue
77 West Wacker Drive
Chicago, IL 60601-1692

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,247

Applicant(s)

COVINGTON ET AL

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,12,13,15-28,32-34,36-39,42-49,51-54,58-61,65 and 67-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,12,13,15-28,32-34,36-39,42-49,51-54,58-61,65 and 67-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/8/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant canceled claims 7, 10, 11, 14, 29-31, 35, 40, 41, 50, 55-57, 62-64, and 66, and amended claims 1, 26, 36, 37, 46, and 58. All pending claims (1-6, 8, 9, 12, 13, 15-28, 32-34, 36-39, 42-49, 51-54, 58-61, 65, and 67-69) were examined in this final office action necessitated by amendment.

Terminal Disclaimer

The terminal disclaimer filed on 15 June 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted for co-pending application 09/705,252 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Regarding Rejection under 35 USC 102

Withdrawn as necessitated by amendment.

Regarding Rejection under 35 USC 103(a)

Applicant's arguments filed 15 June 2005 have been fully considered but they are not persuasive. Robertson teaches buyers viewing a registrant's personal preferences whereby the viewing is permitted because the registrant did not mark the items as private. Newly cited art as necessitated by amendment

Art Unit: 3625

teaches the use of passwords to control access to a registrant's gift registry by buyers.

ON1, ON4, ON5 (regarding well within the skill)

The Applicant did not traverse the examiner's assertion of official notice. The well within the skill statement is admitted as prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice on the merits of the official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-6, 8, 9, 12, 13, 15, 19-21, 24-28, 32-34, 37-39, 42-44, 46-49, 51-54, 58-61, 65, and 67-69 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), in view of Robertson (Paper #20041223, US 6,609,106), further in view of Business Wire (PTO-892, Item: U) and Official Notice (Paper #20041223, admitted regarding well within the skill hereinafter referred to as "ON1").**

LeRoy teaches a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product

selections while physically in a store or create the wish list online (e.g. from home), and customers making actual purchases on behalf of the registrant based on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further teaches:

- Providing a database and a handheld data entry unit including internal memory; Database coupled to a computer server: (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).
- Storing item information (in handheld unit memory; Handheld unit with internal memory to scan physical items: (see at least col. 5, lines 52-55).
- Uploading lists from the internal memory of the handheld unit to the database: (see at least Fig. 1 (15); col. 6, lines 39-67).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (please note examiner's interpretation: creating a list of desired items is a wish list); associates scanned items with registry ID; registrant login requiring username and password (see at least Fig. 2 (R2); col. 2, lines 19-22; col. 7, lines 42-44 col. 9, lines 53-61).
- Identifying retailer: retailer code associated with stock number (see at least col. 7, lines 61-66).
- Providing a web site that allows a buyer to search for an view the wish list: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday). The

mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant) (see at least col. 1, lines 14-17; col. 6, lines 27-33).

- Associating a member with scanned items: customer (please note: "member" is defined by Applicant as a buyer) scans items on a registrant's wish list (see at least col. 5, line 10 through col. 6, line 67).

LeRoy teaches all the above as noted under the 103(a) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but does not specifically disclose creating an access mechanism that notifies selected buyers of the existence of one or more of the wish list. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event

as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 103(a) rejection but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and using email to notifying each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in order to associate a plurality of individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) registrant password usage by the registrant, and b) the registrant marking wish list items as private or not marking as private for public viewing (Robertson: see at least Fig. 31; col. 5, lines 35-38), but do not disclose use of a password for access by buyers. Business Wire teaches an online site featuring a private-multi-member environment for families to gather, facilitate personal relationships, shop, and share information (e.g. gift registry) on the Internet using a password-protected site so that only members invited by the registrant are

allowed to access the registrant's site (U: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of LeRoy and Robertson to implement password protected access by buyers to a registrant's site as taught by Business Wire, in order to facilitate personal relationships, and thereby attract registrants to the online service.

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) scanning items with a portable scanner in the physical retailer that stores registrant gift registry selections in the portable scanner, and b) registrants physically moving about a store to make selections, but do not disclose registering after scanning items. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy and Robertson to disclose registering after scanning, since it is well within the skill to ascertain that accepted retail business practices allow potential gift registry registrants to physically collect item information in a store prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailer's goods are suitable to the potential registrant's wish list.

2. **Claim 16 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claim 15,**

further in view of Schwartz et al. (Paper #20041223, US 5,913,032 hereinafter referred to as “Schwartz”).

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach sending emails to buyers on a distribution list, but do not disclose choosing buyers from an address book. Schwartz teaches electronic address books as simplifying the email process, and further teaches choosing email recipients from an address book to populate distribution lists (see at least abstract; col. 13, line 32 through col. 14, line 33). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and Business Wire and ON1 to choose email recipients from an address book as taught by Schwartz, in order to simplify email processing by the registrant, and thereby attract registrants to the service.

- 3. Claims 17, 36, and 45 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claims 15, 26, and 44, further in view of Official Notice (Paper #20041223, admitted regarding well within the skill hereinafter referred to as “ON4”).**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach or suggest a) issuing an email notification to the user including a embedded link that takes the user directly to preferred web

site (please note: a hyperlink) (see at least Fig. 7 (190); col. 15, lines 19-25), b) issuing an email to a buyer on a user's distribution list, and c) requiring a buyer to use a password to access a private wish list, but do not disclose embedding the password in a hyperlink. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and Business Wire and ON1 to disclose embedding the password in a hyperlink, since it is well within the skill to ascertain the service wants the notified buyer to go directly to the user's wish list in order to make a purchase from the wish list, and thereby provide the buyer a shopping convenience.

4. **Claim 18 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claim 1, further in view of Wireless Data News (Paper #20041223, PTO-892, Item: U hereinafter referred to as "WDA").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach wireless scanning of items, but do not disclose other input devices comprising a wireless telephone and a personal digital assistant. WDA teaches a) a wireless handheld scanning terminal, b) the Wireless Application Protocol (WAP) used for mobile communications and accessing Internet services using cellular phones, and c) a handheld computing

device (e.g. palm-size device with keyboard and screen to help deaf or hard-of-hearing users communicate interactively) (please note examiner's interpretation: a PDA providing the user a computing convenience) (U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson, and Business Wire and ON1 to provide a group of input devices as taught by WDA, in order to accommodate a variety of input devices, and thereby provide a shopping convenience.

- 5. Claims 22 and 23 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claim 1, further in view of Official Notice (#20041223, admitted regarding well within the skill hereinafter referred to as "ON5").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach a) retailers providing merchandise for gift registry buyers, b) organizing wish lists by events (e.g. birthdays), and c) using icon tabs to organized information by events, but do not specifically disclose wish lists organized by specific retailers. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson, and Business Wire and ON1 to organize wish lists by specific retailers, since it is

Art Unit: 3625

well within the skill to ascertain that specific retailers promote events with special pricing (e.g. Washington/Lincoln's birthday), and thereby provide incentives to organize wish lists based on specific retailers.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

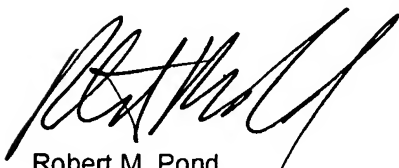
"GiftRegistryWorks now available on the World Wide Web," Business Wire, 09 June 1999, Proquest #42256922, 3pgs; teaches privately accessible gift registries by users at the option of the registrant.

Art Unit: 3625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
August 25, 2005